

REMARKS

Status of Claims

Claims 46, 47, 49 to 51, 54, and 56 to 85 were pending in the application. Of the pending claims, Claims 57, 59 and 63 to 85 were withdrawn from consideration. Claim 46 has been amended by this Reply. No new matter has been added by this amendment. Reconsideration is respectfully requested in light of the amendment and the following remarks.

Remarks on Amendments to the Claims

In the Action, the Examiner held that sufficient support for superimposed solid phase supports is not disclosed in the parent application No. 09/082,038 (see page 2 of the Action), that the “partial eclipse” embodiments is not disclosed in the present application (see page 7), but that superimposed solid phase supports are disclosed in the published PCT Application WO 99/59722, which is based on the parent application. The disclosure and figures of each of these three patent cases are essentially the same.

Relying on terminology in non-analogous art, the Examiner posits that there are two variations of superimposed positions, namely “partial eclipsed” and “fully eclipsed”. As admitted by the Examiner, there is support in the specification of the present and parent cases for the fully eclipsed interpretation of the term superimposed. In order for any selected rod to be inserted into a plurality of solid phase supports, the solid phase supports need to be in the fully eclipsed position. If the apertures of the solid phase supports do not align, as would be the case for the partial eclipsed variation of the term “superimposed”, then the rod will not be able to extend through a plurality of the solid

phase supports. Because it is not proper to interpret the terms of a claim in a way to make the claim inoperative, the term “superimposed” refers to the eclipsed variation.

Nonetheless, in order to expedite the prosecution of the present application, Claim 46 has been amended by deleting the term “superimposed” and adding the phrase -- wherein the solid phase supports in the columns are substantially aligned --. The support for this amendment is found in specification, including page 41, lines 1 to 3 (corresponding to Application Publication 2004/0058391, paragraph [0099], fourth sentence). Furthermore, Figure 29 shows solid phase supports are stacked on top of each other, and are aligned so that a rod is inserted through their aligned apertures extending therethrough. Still furthermore, Figure 17 shows two solid phase supports that are aligned, so that a rod is inserted through the aligned apertures of the solid phase supports.

This configuration as claimed in Claim 46 is fully supported by the published application which, in turn, is entitled to the priority of its parent, Application No. 09/082,038 of May 20, 1998, now U.S. Patent 6,872,535.

Because all of the claims are entitled to the priority of May 20, 1998, published PCT Application No. WO 99/59722 (published November 25, 1999) cannot serve as a §102(b) prior art. A withdrawal of the §102(b) rejection is requested respectfully.

In re Application of S. A. Baum
Application No. 10/671,341

Atty. Docket No. P26,015 US1
Reply to Office Action dated July 27, 2007
Reply dated October 29, 2007

Conclusion

In view of the foregoing claim amendments and remarks, the Applicant requests that the claims be allowed. In the event any issues remain outstanding, the Examiner is requested to call the undersigned at the telephone number listed below.

The Commissioner is authorized hereby to charge any additional fees or credit any overpayment associated with this Reply to Deposit Account No. 19-5425.

Respectfully submitted,

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